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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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09/103,072 06/23/98 TRUCKAI

C ENVS-220

EXAMINER

QM31/0621

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ART UNIT PAPER NUMBER

3762

DATE MAILED:

06/21/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 6/23/98
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-31 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4, 6, 7, 9-14, 16, 18-23, 25-31 is/are rejected.
- ☒ Claim(s) 5-7, 15, 17, 24 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

BEST AVAILABLE COPY

Art Unit: 3762

## **DETAILED ACTION**

### ***Drawings***

1. Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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3. Claims 1, 3, 8, 16, 22, 25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Stern et al '470.

Stern et al '460 discloses the invention substantially as claimed including an expandable member constructed of open-cell, porous material which do to its structure will act to absorb moisture when this surface is not coated with a paste or gel.

4. Claim 31 is rejected under 35 U.S.C. 102(e) as being anticipated by Edwards.

Edwards discloses an elongate member (15), a deployment mechanism (12), an electrode array (40), a sheath (14), a handle (16), a limiting means (20, 22, 23, 24) and a source of RF energy is supplied to the electrodes (column 4, line 46).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 9-14, 18-22 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern et al '470.

Stern et al '470 discloses the invention substantially as claimed except for the fluid permeable member including a variety of fabrics, the step of measuring the length and width of the organ being treated and width measurment means. The material used in the construction of the

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permeable member would have been an obvious design choice in the absence of any new or unobvious results, the material being used being dependent upon its absorption properties and biocompatibility with the body. It would be obvious to one of ordinary skill in the art to survey the organ being treated as to its size, shape etc. as a preliminary step in the treatment procedure. Measurement means is accomplished by comparing the dimensions of the organ to the known measurements of the treatment mechanism.

7. Claims 4, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern et al. '470 in view of Chin (WO 95/07664).

Stern et al. '470 discloses the invention substantially as claimed except for the use of spring members to assist in the deployment of the electrode carrying member. Chin discloses spring members (50, 52) which assist in the deployment of the balloon (10) into proper configuration in the uterus during organ ablation. It would have been obvious to one of ordinary skill in the art to provide similar additional support means in the balloon structure of Stern et al. In order to assist in the proper placement of the device in the uterus for the ablation procedure.

***Allowable Subject Matter***

8. Claims 5-7, 15, 17 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not teach openings in elements of the device for actively withdrawing moisture from the treatment site.

*Conclusion*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kent Gring whose telephone number is (703) 308-2214. The examiner can normally be reached on Monday - Friday from 9:00 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
Kent Gring

June 18, 1999

  
CORRINE McDERMOTT  
PRIMARY EXAMINER